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REMARKS

Claims 1 - 21 are pending in the present Application. Claims 1 and 11 - 21 have been cancelled, Claims 2 - 10 have been amended, and Claims 22 - 31 have been added, leaving Claims 2 - 10 and 22 - 31 for consideration upon entry of the present Amendment. The Specification has been amended to correct certain typographical errors.

Claim 6 has been amended to correct a typographical error.

Claims 5, 7, and 8 have been amended to place them in independent form.

Claim 8 has been amended to change "component" to "compound" as in Claim 1, and to add a period at the end of the claim. Support for this amendment can at least be found in Claims 1 and 8 as originally filed.

Claims 2 - 4, 9, and 10, have been amended to correct the claim dependency.

Claims 22 - 31 have been added to further claim the present invention. Support for these new claims can at least be found in Paragraphs [0027], [0036], [0038], and [0039] as originally filed.

No new matter has been introduced by these amendments or new claims. Reconsideration and allowance of the claims are respectfully requested in view of the above amendments and the following remarks.

Elections/Restrictions

The Examiner contends that: Group I, Claims 1 - 10, classified in Class 502, subclass 101; and Group II, Claims 11 - 21, drawn to a method of making a membrane electrode assembly, classified in Class 429, subclass 30. Pursuant to MPEP §§806.04, 806.05(c), 806.05(d), 808.01, and 35 U.S.C. §121 the Examiner requires restriction between Groups I and II.

Accordingly, pursuant to 35 U.S.C. §121, Applicants confirm the election of Group I, Claims 1 - 10. This election is being made without prejudice to Applicants' rights with respect to Claims 11 - 21, Group II, including the right to file divisional application(s) thereon.

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Objections

Claims 6 and 7 have been objected to because of informalities. Claims 6 and 7 have been amended. Reconsideration and withdrawal of this objection are respectfully requested.

Rejections Under 35 U.S.C. § 112, Second Paragraph

Claim 8 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 has been amended to change "component" to "compound" as in Claim 1. Reconsideration and withdrawal of this rejection are respectfully requested.

Claim Rejections Under 35 U.S.C. § 102(b)

Claims 1-10 stand rejected under 35 U.S.C. § 102(b), as allegedly anticipated by U.S. Patent No. 6,492,295 to Hitomi et al. Applicants respectfully traverse this rejection.

Claim 1 has been cancelled and Claims 5, 7, and 8 have been placed in independent form. All of the remaining claims ultimately depend from these three independent claims.

To anticipate a claim, a reference must disclose each and every element of the claim. *Lewmar Marine v. Varient Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987).

Regarding Claim 5, the Office Action refers to the non-enabling teaching of Hitomi et al. that the weight of the cation-exchange polymer to the catalyst particles is not particularly limited, but is preferably from 1.0 to 100 wt%. (Office Action, page 5) Claim 5 of the present application specifically recites amounts for each of the claim elements. A statement that any amount can be used and disclosure of an essentially unlimited range does not enable the ranges claimed in Claim 5. Additionally, several of the elements are not mentioned in this alleged anticipation of this claim. Anticipation requires a teaching of each element of the claim. Hitomi et al. fail to teach all of the elements of Claim 5, and therefore fail to anticipate Claim 5.

Regarding Claim 7, it is alleged that the density is inherently encompassed by the catalyst composite of Hitomi et al. (Office Action, page 6). In order to support an anticipation rejection based on inherency, an Examiner must provide factual and technical grounds establishing that the inherent feature necessarily flows from the teachings of the prior art. *Ex parte Levy*, 17

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U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int. 1990); *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981) (holding that inherency must flow as a necessary conclusion from the prior art, not simply a possible one). Here, it does not matter if the ink may possibly be configured to have the claimed density. The claimed density must necessarily flow from the teachings of Hitomi et al. There is no teaching or basis in fact or technical reasoning to support a position that the claimed density necessarily flows from the teachings of Hitomi et al. Hence, Hitomi et al. fail to anticipate Claim 7.

Regarding Claims 8 and 9, the Office Action refers to the platinum having a diameter of 2.4 nm and the carbon support having a diameter of 30 nm and alleges that reads on the catalyst having a size of about 10 nanometers to about 100 nanometers. (Office Action, page 5) Claims 8 and 9 are directed to the catalyst compound as defined therein, e.g., to the size of the platinum, not the size of the carbon. The platinum of Hitomi et al. has a size of 2.4 nm; well below the about 10 to about 100 nm claimed in the present application. Since Hitomi et al. fail to teach this element of Claims 8 and 9, Hitomi et al. fail to anticipate this claim.

Reconsideration and withdrawal of this rejection are respectfully requested.

Claims 1-3, 7, 8, and 10 are rejected under 35 U.S.C. § 102(b), as allegedly anticipated by U.S. Patent Application Publication No. 2002/0182478 to Uchida et al. Applicants respectfully traverse this rejection.

Claim 1 has been cancelled and Claims 5, 7, and 8 have been placed in independent form. All of the remaining claims ultimately depend from these three independent claims.

To anticipate a claim, a reference must disclose each and every element of the claim. *Lewmar Marine v. Varient Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987).

Regarding Claim 7, it is alleged that the density is inherently encompassed by the catalyst composite of Uchida et al. (Office Action, page 7). In order to support an anticipation rejection based on inherency, an Examiner must provide factual and technical grounds establishing that the inherent feature necessarily flows from the teachings of the prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int. 1990); *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981) (holding that inherency must flow as a necessary conclusion from the prior art, not simply a possible one). Here, it does not matter if the ink may possibly be

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configured to have the claimed density. The claimed density must necessarily flow from the teachings of Uchida et al. There is not teaching or basis in fact or technical reasoning to support a position that the claimed density necessarily flows from the teachings of Uchida et al. Hence, Uchida et al. fail to anticipate Claim 7.

Regarding Claim 8, the Office Action refers Paragraphs [0083] – [0084]. (Office Action, page 7) In these paragraphs, supporting carbon particles are described as having a diameter of 0.1 to 3 μm . This section does not teach the catalyst compounds set forth in Claim 8 as having a size of about 10 nanometers to about 100 nanometers. Claims 8 and 9 are directed to the catalyst compound as defined therein, e.g., to the size of the platinum, not the size of the carbon. Hence, Uchida et al. fail to anticipate Claim 8.

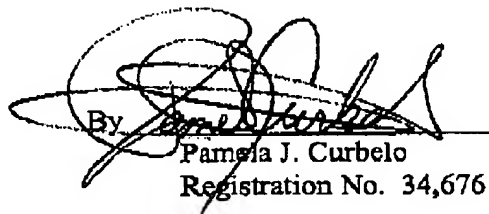
Reconsideration and withdrawal of this rejection are respectfully requested.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and withdrawal of the rejection(s) and allowance of the case are respectfully requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully submitted,

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